

REMARKS

Amendments to the claims

Claims 1-6, 10-17, 20 and 22-81 are unchanged; claims 7-9, 18, 19, 21 and 82 were rewritten in the dependency of claim 2.

Restriction Requirement

In the Action, the Examiner opines that pending claims 1-82 comprise five groups relating to a different invention each:

Group I comprises claims 1-6 and 10-17;

Group II comprises claims 1, 22-32;

Group III comprises claims 1, 36-45;

Group IV comprises claims 46-67 and 75-77; and

Group V comprises claims 68-74 and 78-81.

The Examiner recognizes that claim 1 is generic for groups I, II and III but opines that claim 1 is not patentable in view of US2002/0190520 to Garross.

In response to the Examiner, the Applicants (i) provisionally elect Group I and (ii) submit that in addition to claims 1 to 6 and 10-17, claims 7-9, 18-21 and 33-35 also belong to group I. The Applicants note that, by issuing the above restriction requirement, the Examiner opines that the subject matter of the subsets of claims are not "obvious variants".

The Applicants respectfully submit that the Examiner is expected to have a consistent approach as to what is, or is not, an "obvious variant" if the Examiner issues an obviousness rejection of the elected claims in a future Office Action.

Further, the Applicants respectfully traverse the restriction requirement because of at least the following reasons:

Under proper USPTO practice (section 817 of the MPEP), an Examiner issuing a restriction requirement under 35 USC 121 must:

(A) State that the requirement to restrict is being made under 35 U.S.C. 121; (1) Identify each group by Roman numeral; (2) List claims in each group; (3) Give short description of total extent of the subject matter claimed in each group, pointing out critical claims of different scope and identifying whether the claims are directed to a combination, subcombination, process, apparatus, or product; and (4) Classify each group.

(B) Take into account claims not grouped, indicating their disposition.

(C) in an Allegation of independence or distinctness: (1) Point out facts which show independence or distinctness; and (2) Treat the inventions as claimed.

(D) Provide reasons for insisting upon restriction, including: (1) Separate status in the art; (2) Different classification; (3) Same classification but recognition of divergent subject matter; (4) Divergent fields of search; (5) Search required for one group not required for the other

(E) in a Summary statement: (1) Summarize (i) independence or distinctness and (ii) reasons for insisting upon restriction; (2) Include paragraph advising as to reply required; (3) Indicate effect of allowance of linking claims, if any present; (4) Indicate effect of cancellation of evidence claims; and (5) Indicate effect of allowance of product claims if restriction was required between a product and a process of making and/or using the product.

The Applicants respectfully submit that the Examiner has at least failed to: (A)(4) classify each group (what are the classes of Group I to V ?); and (B) Take into account claims not grouped (what about claims 7-9, 18-21 and 33-35 ?).

In addition, the Examiner inaccurately asserts that Group IV is "drawn to a security apparatus adapted to be provided on or as a part of an item to be secured".

However, independent claim 46 of Group IV recites: "A security apparatus comprising: a security device adapted to be provided on or as part of an item to be secured, the security device comprising" a number of features.

Unambiguously, it is the security device in the apparatus that is "adapted to be provided on or as part of an item to be secured", not the apparatus.

The Applicants respectfully submit that the Examiner has failed to show why the security device recited in claim 1 would be patentably distinct from an apparatus having a security device as recited in claim 46, and that at least because of this, the restriction requirement of Group IV is not proper.

The Applicants further note that because claim 68 is directed at a method of securing an item comprising providing a security device with all the limitations recited in claim 46, if claim 46 is ultimately found patentable, claim 68, as well as the claims of Group V should be rejoined with claim 46 and its dependent claims.

* * *

The Examiner further opines that claim 1 is not considered patentable over Garross (US 2002/0190520). The Applicants respectfully disagree with the Examiner.

For example, the Applicants note that the Examiner has failed to show why Garross would disclose a secondary image comprising one or more primary images and a decoding mask as recited in claim 1.

The Examiner has failed to show that Garross would disclose a decoding mask as recited in claim 1, having a plurality of spaced apart transparent viewing portions. The Examiner has failed to show that Garross would disclose an arrangement where "when said viewing portions of the mask, said secondary image and an observer are located in one or more predetermined alignments for each said one or more encoded primary images, the primary image elements from the secondary image may be observed through the viewing portions, whereby the corresponding primary image may be observed along a line of sight corresponding to said predetermined alignment".

The Garross patent relates to a one use device which allows for an irreversible security overprint. That is, the purpose of the underlying image in Garross is to be used as a substrate for printing of a further image in such a manner that the further image cannot then be altered. The Applicants note that the overprinting which occurs in Garross does not amount to a mask as recited in claim 1.

In particular, Garross teaches (claim 1 of Garross) providing a media having a 2D pattern; and "overprinting the media to obscure or otherwise modify predetermined elements of said pattern to alter a visual geometry or color of the pattern so as to encode predetermined information". The Applicants note that, whatever broad meaning the Examiner gives to the word "mask" in Garross, Garross discloses overprinting a media, and does not disclose or suggest a mask as in claim 1, and in particular a mask "separated from the secondary image".

The Applicants respectfully submit that at least because of the above differences, claim 1 is patentable over Garross. It follows that Group I, II and III actually form a single group, contrary to the assertion of the Examiner.

* * *

In view of the above, Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue.

The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

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United States Patent and Trademark Office on

March 2, 2009
(Date of Transmission)

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March 2, 2009
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